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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/390,851	09/07/1999	HENRIK PEDERSEN	5655.204-US	7651

25908 7590 12/04/2001

NOVOZYMES NORTH AMERICA, INC.
C/O NOVO NORDISK OF NORTH AMERICA, INC.
405 LEXINGTON AVENUE, SUITE 6400
NEW YORK, NY 10174

EXAMINER

PRASTHOFER, THOMAS W

ART UNIT	PAPER NUMBER
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1627

DATE MAILED: 12/04/2001

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary*file copy*

Application No.

09/390,851

Applicant(s)

PEDERSEN ET AL.

Examiner

Thomas W Prasthofer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 28-55 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Detailed Action
(Substitute Restriction/Election)

Status of the Application

Receipt is acknowledged of a response to a restriction and election of species requirement with accompanying amendment on 20 September 2001 (Paper No. 16).

Status of the Claims

Claims 1-27 were pending in the present application. Claims 1-27 were cancelled and new claims 28-55 were added by amendment in Paper No. 16. Claims 28-55 are now pending and are subject to restriction and election of species requirements.

Reasons for Substitute Restriction/Election

Upon further consideration and in light of the replacement of claims 1-27 with new claims 28-55, the examiner sets forth the following substitute restriction and election of species requirement. The examiner regrets the need for the following additional restriction requirement and will strive to provide a compact prosecution of the application.

Restriction/Election

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 28-34 (in part), 35-39, 48 (in part), 49, 50-55 (in part), drawn to a method for identifying a catalyst of interest from a library of catalysts, wherein the catalysts comprise peptides or polypeptides, classified in class 435, subclass 183.

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- II. Claims 28-34 (in part), 40-43, and 48 and 50-55 (in part), drawn to a method for identifying a catalyst of interest from a library of catalysts, wherein the catalysts comprise nucleic acids, classified in class 536, subclass 22.1.
- III. Claims 28-34 (in part), 44, 45, and 48 and 50-55 (in part), drawn to a method for identifying a catalyst of interest from a library of catalysts, wherein the catalysts comprise small organic molecules, classified in numerous classes and subclass, depending on the structures of the catalysts.
- IV. Claims 28-34 (in part), 46, 47, and 48 and 50-55 (in part), drawn to a method for identifying a catalyst of interest from a library of catalysts, wherein the catalysts comprise small inorganic molecules, classified in numerous classes and subclass, depending on the structures of the catalysts.

The inventions are distinct, each from the other because:

Inventions I-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are methods for identifying a catalyst of interest from a library of catalysts. The specification does not disclose the capability of simultaneous identification of combinations of inorganic, small organic, enzyme, and nucleic acid catalysts. The different types of catalysts require mutually exclusive reagents, reaction conditions, catalyze different types of reactions, and produce different types of products.

Election of Species

2. This application contains claims directed to patentably distinct species of the claimed invention. Applicant is required to elect a distinct species within each of the following categories: (a total of seven species to be elected)

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- A. catalytic activity of interest (i.e. to catalyze a *particular* reaction or *class of* reactions, as opposed to the generic of any catalytic reaction or alteration to a generic activity),
- B. species of biologically amplifiable unit (i.e. phage, plasmid, virus, bacterium, etc.),
- C. substrate (named or structurally identified specific molecule or class of structurally related molecules used as substrates, and not the generic of "substrate" for a reaction),
- D. species of selecting in claim 1 (ii) (i.e. method of selection),
- E. species of attachment of catalyst to substrate (i.e. covalent, ionic interaction, etc.)
- F. ultimate species of flexible linker in claim 31 (i.e. exact structure of the linker), AND
- G. species of carrier system in claim 32 (what is the carrier system),

3. The species are distinct, each from the other, because they have different chemical, physical, biological, and catalytic properties or they are different methods requiring different method steps, reagents, starting materials, and reaction conditions and/or produce different results. Therefor, different issues of enablement and patentability apply to each species and each species represents patentably distinct subject matter.

4. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims all claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and **a listing of all claims readable thereon, including any claims subsequently added**. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Thomas Prasthofer** at telephone number **(703) 308-4548**. The examiner can normally be reached on Monday, Tuesday, Friday, and Saturday 8:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2742.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-1235.

BENNETT CELSA
PRIMARY EXAMINER


12/3/01

Thomas Prasthofer, Ph.D.

December 2, 2001

